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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/832,443 04/03/97 WOLPE S 1931-2220#M#

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EXAMINER

TUNG, M

ART UNIT

PAPER NUMBER

1644

14

DATE MAILED:

11/24/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/832,443

Applicant(s)
Wolpe And Tsyrova

Examiner
Mary B. Tung

Group Art Unit
1644



X Responsive to communication(s) filed on 3/4/99 and 6/30/99

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11, 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

X Claim(s) 1-90 is/are pending in the application.

Of the above, claim(s) 1-46 and 53-90 is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

X Claim(s) 47-52 is/are rejected.

Claim(s) _____ is/are objected to.

Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) _____

received in this national stage application from the International Bureau (PCT Rule 17 2(a))

*Certified copies not received: _____

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of Draftsperson's Patent Drawing Review, PTO-948
Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

1. Claims 1-90 were originally presented, claims 1-46 and 53-90 were drawn to a non-elected invention.

CRF Requirements

2. This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 C.F.R. 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 C.F.R. 1.821 through 1.825 for the reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures.

3. SEQ ID NO: 34, recited in claim 49 is disclosed in the paper Sequence listing filed 6/25/99 but was not found by STIC on the diskette submitted with the listing. A new paper listing and diskette are required as set forth in the Notice to Comply With Sequence Requirements.

Election/Restriction

4. Applicant's election of Group XVIII, claims 47-52 in the paper filed March 4, 1999, Paper No. 10 is acknowledged. Because Applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). The Examiner further clarifies that "Group XVII" at page 5, line 6 of the Action mailed Sept. 4, 1998 should have read as "Group XVIII".

5. Groups II-VIII, claims 5-10, 12 and 14-25 are withdrawn from further consideration by the Examiner, 37 C.F.R. 1.142(b), as being drawn to non-elected inventions, the requirement having been traversed in Paper No. 5.

6. Applicant has further elected in Paper No. 10, the species "JJ", (SEQ ID NO: 1). The Examiner clarifies that the species requirement includes claim 49, which is part of elected Group XVIII. The Examiner appreciates the clarification by the Applicants. Since the elected species was allowable over the prior art, all species have been rejoined. Also, the

The requirement is still deemed proper and is therefore made FINAL.

Information Disclosure Statement

8. The information disclosure statement filed in Papers 3 and 4 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered. The Russian patents have not been considered by the examiner.

Claim Objections

9. Claims 47 and 48 are objected to because of the following informalities: Claim 47 is incomplete in that text is missing. The Applicants have pointed out in Paper No. 10 the proper intended wording of the claim. The Applicants are required to amend the claim to delete "con" in line 1, and insert thereto "contacting". Additionally, Claim 48 needs to be amended to insert a space in line 2 after the word "hemoglobin,".

Claim Rejections - 35 U.S.C. § 112

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the Applicant regards as his invention.

11. Claim 47-52 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

12. Claims 47 and 49 recite the word "INPROL". It is improper to recite a non-defined term in the claims. To overcome this rejection, the Applicants are required to define the term in the claims.

13. Claim 47 recites the term "and/or" which renders the claim indefinite because it is unclear if the Applicants intend the claim to be recited in the alternative.

14. Claim 50 contains the trademark/trade names DAMGO and DALDA. Where a

trademark or trade name is used in a claim, it must be used to identify a source of goods or services. See *Ex parte Simpson*, 218 U.S.P.Q. 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or

trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe an opiate compound and, accordingly, the identification/description is indefinite. If the terms are not trademarks, proper identification of the compounds is required in order to describe the recited product.

Claim Rejections - 35 U.S.C. § 102

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the Applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the Applicant for patent.

16. Claims 47-49 and 51 are rejected under 35 U.S.C. 102(b) as being anticipated by Petrov, et al. (US Patent #5,786,334).

17. The '334 patent teaches a method of stimulating the proliferation of peripheral blood lymphocytes and antibody production from lymph node cells (see col. 1, lines 47-51 and col. 2, lines 42-45) by contact with alpha and beta chains of hemoglobin, as recited in claim 48, which are also taught by the '334 patent to have opioid activity (see col. 1, lines 55-60). The '334 patent further teaches the fragments of SEQ ID NO: 3 and SEQ ID NO: 4 with 100% identity with SEQ ID NOS: 34 and 8, respectively, as recited in claim 49, of the instant application have such activity. **Note:** the word "having" is interpreted as open, thus any sequence of any size would read upon the claimed invention, if the recited sequences are part of the reference sequence. Also, the opioid activity of the taught sequences are assumed to have the ability to bind to opiate receptors, as recited in claim 51. The fragments taught by the '334 patent are assumed to be included in the recited designation of "INPROL" as recited in claims 47 and 49. The term "stem cells" are interpreted as being cells capable of long-term culture as defined in the specification on page 63, lines 17 and 18. Therefore, the reference teachings anticipate the claimed invention.

Allowable Subject Matter

Conclusion

19. Papers related to this application may be submitted to Group 1640 by facsimile transmission. Papers should be faxed to Group 1640 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). THE CM1 FAX CENTER TELEPHONE NUMBER IS (703) 305-3014 or (703) 308-4242.

20. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Mary Tung whose telephone number is (703)308-9344. The Examiner can normally be reached Tuesday through Friday from 8:30 am to 6 pm, and on alternating Mondays. A message may be left on the Examiner's voice mail service. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1640 receptionist whose telephone number is (703) 308-0196.

November 22, 1999
Mary B. Tung, Ph.D.
Patent Examiner
Group 1640

David A. Saunders

DAVID SAUNDERS
PRIMARY EXAMINER
ART UNIT 182 1047